REMARKS/ARGUMENTS

Rejection under 35 U.S.C. § 103

Claims 1-13 and 17-53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Filepp et al. 5,347,632 and Kikinis 5,727,159 and further in view of Makipaa 6,556,217. Applicants respectfully request reconsideration of these claims and request that the rejection be withdrawn at least because (a) these references fail to teach or suggest all of the claim limitations as required by MPEP § 2143, and (b) these references are not properly combinable.

(a)   *UI Form Based On Client Device Capabilities*

Independent claims 1, 17, 32, 36, and 45 recite defining or generating a user interface form <u>based upon or being dictated by a number of device capabilities for a client device</u>. Specifically, claims 1, 32, and 36 recite a UI form based upon a number of device capabilities for the client device "including a client device operating system, a client device maximum receivable packet size, and a list of available client device native UI controls." Claim 17 similarly recites that the device capabilities include "a client device operating system and a client device maximum receivable packet size," and claim 45 recites that the device capabilities include "the operating system and a list of available client device native UI controls."

Examiner agrees that Filepp fails to teach these limitations (see, OA dated 9/21/06, p. 4, "Filepp does not explicitly say generating according to a UI format that is based upon a number of device capabilities for said client device"), but rather the rejection relies on Kikinis as teaching this limitation. Specifically, the rejection cites passages in Kikinis at Col. 2, lines 48-51 and Col. 10, lines 20-33, which state, "In various embodiments of the invention the Proxy-Server downloads data comprising WEB pages and transposes the data to match the specific <u>size and resolution of the display of the field computer</u>" and "At step 101 the Proxy-Server converts all of the .jpg files to a dithered bitmap format according to information associated with the user ID received from the hand-held at log-on. This ID establishes the <u>size and resolution of the hand-held's display</u>, for example, and the bitmap created from the .jpg files is scaled to the hand-held's display" respectively. (emphasis added). However, the reference only describes converting electronic image file formats according to a client device's <u>display size and resolution</u>.

In contrast, the claims of the present invention require a UI form based upon a number of device capabilities for the client device including a client device operating system, a client device maximum receivable packet size, and a list of available client device native UI controls. These recited capabilities do not read on a client device's <u>display size and resolution</u>, which are taught by Kikinis. Moreover, the recited capabilities are not taught by the remaining art of record, which does not disclose a UI form based on such capabilities suitable for thin client devices.

Examiner agrees that the combination of Filepp and Kikinis does not teach these limitations (see, OA dated 9/21/06, p. 4, "The combination of Filepp and Kikinis does not teach a client device operating system, a client maximum receivable packet size, and a list of available client device native UI controls" but rather the rejection relies on Makipaa as teaching this limitation. Specifically, the rejection cites passages in Makipaa at Col. 3, lines 2-11, lines 14-52; and Col. 7, lines 51-67, which state "This method identifies a user terminal type and screen size upon logon of a user terminal. It then extracts layout rules and typographical settings from a database based on the user terminal type." Also, it states "By operation 230, the pagination and terminal adaptation module 90 has access to the terminal profile 140 and therefore is aware of the terminal capabilities. These capabilities would include, but not limited to, screen size, bandwidth, color vs. black and white, media types supported by this terminal type (i.e., video/audio, animation, etc.) and input capabilities." These capabilities are similar to Kikinis as they deal with the terminal's <u>display size and resolution</u>.

In contrast, the claims of the present invention require a UI form based upon a number of device capabilities for the client device including a client device operating system, a client device maximum receivable packet size, and a list of available client device native UI controls. These recited capabilities do not read on a client device's <u>display size and resolution</u>, which are taught by Makipaa. Moreover, the recited capabilities are not taught by the remaining art of record, which does not disclose a UI form based on such capabilities suitable for thin client devices.

    (b)   <u>Filepp</u> *and* <u>Kikinis</u> *and* <u>Makipaa</u> *References Are Not Properly Combinable*

Moreover, the Filepp, Kikinis and Makipaa references are not properly combinable because the Filepp reference teaches away from being modified or combined with other references to achieve the present claimed invention:

> A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

In re Gurley, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130, 1131 (Fed.Cir.1994). The Court also noted that there is "no suggestion to combine" references where one reference deliberately seeks to avoid a teaching of the other reference. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed.Cir.1988). When deliberating on prior art, "A prior art reference must be considered in its entirety, i.e., as a <u>whole</u>, including portions that would lead away from the claimed invention." MPEP § 2141.02 (VI).

In the present application, whereas Filepp is directed towards an architecture that reduces the load on the <u>server</u> and provides for a fat client (i.e., client that performs the bulk of the data processing operations), Kikinis, Makipaa and the present invention are directed towards an architecture that reduces the load on the <u>client</u> and provides for a thin client (i.e., server that performs the bulk of the data processing operations, *see Kikinis* Col. 2, lines 26-36; Col 6, lines 6-36 and *see Makipaa* Col. 5, lines 15-62). Accordingly, considering each reference "in its entirety, i.e., as a <u>whole</u>, including portions that would lead away from the claimed invention," one skilled in the art would not reasonably combine Filepp with Kikinis and Makipaa, or any other reference, to teach or suggest the limitations of the present claimed invention. MPEP § 2141.02 (VI).

The present invention is directed towards a thin client architecture, where substantial proportions of the processing are performed server-side to <u>reduce the load on the client</u>. *See* claims 1, 17, 32, 36, and 45; *see, also*, Spec. p. 6, lines 19-21 ("A preferred embodiment of the present invention provides a data communication architecture that exhibits the following attributes: a relatively thin client for <u>reduced client-side resource demands</u>...") (emphasis added)

In stark contrast, Filepp is directed towards an architecture that reduces the load on the <u>server</u> and provides for a fat client:

> ...the invention includes procedures for formulating objects that have been specially structured to include display data, <u>control data and program instructions</u> for supporting the applications at the network reception systems, the objects being pre-created, parceled units of information that may be <u>distributed and stored at lower levels in the network</u>...<u>so as to reduce processing demand on the network higher element</u>...

Col. 2, line 60-Col. 3, line 1 (emphasis added); *see, also* Col. 76, lines 37-47 ("the table can be presented to the user's RS 400, where the [client-side] RS 400 can provide the data processing required to present the potentially relevant keywords, objects and associated applications to the user...<u>this procedure reduces demand on server</u>..."); *see, also* Col. 1, lines 16-25 ("This invention relates generally to a distributed processing...computer network in which the interactive text/graphic sessions are comprised of pre-created blocks of data and <u>program instructions which may be distributed downwardly in the network</u> for use at a software enhanced user computer terminal that <u>reduces processing demand on the higher-level network elements</u>..."); *see, also* Col. 75, lines 41-56 ("the method aspect of the invention includes an improved procedure for searching and retrieving applications from the store of applications distributed throughout network...<u>this reduces the demand on the server</u>...").

Accordingly, Filepp teaches away from being modified or combined with other references to achieve the present claimed invention. One of ordinary skill in the art would not be motivated to combine the Filepp (fat client) reference with Kikinis (thin client) or Makipaa (thin client) to achieve the present claimed invention because the data processing allocation of each these references are incompatible. Considering the Filepp reference "in its entirety, i.e., as a whole, <u>including portions that would lead away from the claimed invention</u>," one skilled in the art would not reasonably combine Filepp with Kikinis and Makipaa.

Claims 2-13 depend directly or indirectly from claim 1 and are patentable for at least the reasons described above with respect to claim 1.

Claims 18-31 depend directly or indirectly from claim 17 and are patentable for at least the reasons described above with respect to claim 17.

Claims 33-35 depend directly or indirectly from claim 32 and are patentable for at least the reasons described above with respect to claim 32.

Claims 37-44 depend directly or indirectly from claim 36 and are patentable for at least the reasons described above with respect to claim 36.

Claims 46-53 depend directly or indirectly from claim 45 and are patentable for at least the reasons described above with respect to claim 45.

Claims 14-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Filepp et al. 5,347,632 and Kikinis 5,727,159 and further in view of Makipaa 6,556,217. Claims 14-16 depend directly or indirectly from claim 1 and are patentable for at least the reasons described above with respect to claim 1.

This application now stands in allowable form and reconsideration and allowance is respectfully requested.

Respectfully submitted,

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